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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,645	11/16/1999	AVERY FONG	5244-0109-2	3214
22850	7590	11/27/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2007	ELECTRONIC

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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/440,645

Filing Date: November 16, 1999

Appellant(s): FONG ET AL.

James J. Kulbaski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/22/2007 appealing from the Office action mailed 3/27/2007.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6108492	Miyachi	8-2000
US 6026380	Weiler et al	2-2000
US 5414494	Aikens et al	5-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyachi (U.S. Patent Number 6,108,492) in view of Weiler et al. (U.S. Patent Number 6,026,380), hereinafter referred to as Weiler.

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3. Miyachi disclosed a multifunction peripheral that monitors and stores its status information and reports it to a host computer. In an analogous art, Weiler disclosed a method for recording usage information of a peripheral for accounting and billing purposes.

4. Concerning claims 1, 10, 19, and 28, Miyachi did not explicitly state monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations. Miyachi does teach monitoring selections of the operations at the operation panel. Clearly a multifunction peripheral such as Miyachi's must monitor user input at the operation panel in order to effectuate the proper operations requested by the user. However, Miyachi is not explicit on monitoring a more specific sequence, timing, or frequency of this user input. This type of monitoring of the peripheral's operation panel was well known in the art, though, as evidenced by Weiler whose system monitors certain sequences of input and also the timing of user input for controlling a peripheral device. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Miyachi by adding the ability to monitor at least one of a sequence, timing, or frequency of selecting of the plurality of operations as provided by Weiler. Here the combination satisfies the need for recording usage information in a peripheral device which is inexpensive to install, maintain, and repair. See Weiler, column 1, lines 26-28. This rationale also applies to those dependent claims utilizing the same combination.

5. Also concerning claims 1, 10, 19, and 28, Miyachi did not explicitly state that the image forming device has direct network access. Although Miyachi does teach that his

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multifunction peripheral has network access this access is via a host computer. However, providing an image forming device with direct network access was well known in the art at the time of the applicant's invention. It was obvious in the field of computer networks to combine the functionality of multiple computers distributed across the network into a single device or to take the functionality in one device and distribute it over multiple computers across the network. Thereby, direct network access could have easily been incorporated into Miyachi's multifunction peripheral. In addition, Miyachi clearly states the use of image forming devices that have direct network access. See figure 1, printers 180. Although these devices are different from Miyachi's multifunction peripheral with a monitoring unit and a communicating unit, they show that the ability to provide an image forming device with direct network access was already well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Miyachi by adding the ability for the image forming device to have direct network access.

6. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method, a computer program product, or an alternative system are rejected under the same rationale applied to the described claim.

7. Line citations in the following section refer to Miyachi unless otherwise noted.

Thereby, the combination of Miyachi and Weiler discloses:

- <Claims 1, 10, 19, and 28>

A system comprising:

an image forming device having direct network access (figure 1, MFP 110a with LAN 100 or PSTN 130, and obviousness as discussed above concerning "direct" network access) and including an operation panel, the operation panel comprising a plurality of operations to be selected by a user (column 5, lines 27-32);

a monitoring unit configured to monitor data of selecting of the plurality of operations of the operation panel by the user, including monitoring at least one of a sequence, timing, or frequency of selecting of the plurality of operations, and to generate a log of the monitored data (column 5, lines 57-65 and Weiler, column 4, lines 48-63), the log of the monitored data being in a form of a map mapping each of key data in a key portion of the map to respective value data in a corresponding value data portion (columns 6-7, table 1);

a communicating unit configured to receive a command to send information based on the log of the monitored data, and to send the information of the monitored data through the direct network access (column 10, lines 36-42 and 58-65, and figure 2, items 210, 215, 260, and 265), and

wherein the monitoring unit and communicating unit are self-contained in the image forming device prior to any initial external communication connection by the communication unit, and the monitoring unit is configured to generate the log of the

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monitored data without any initial external communication connection by the communicating unit (figure 2, item 110a and column 5, lines 57-65).

- <Claims 7, 16, 25, and 34>

A system according to Claim 1, wherein the key data and the value data in the map both contain string data (columns 6-7, table 1).

- <Claims 8, 17, 26, and 35>

A system according to Claim 7, wherein the value data portion includes plural vectors in which each vector includes an array of strings (columns 6-7, table 1).

Since the combination of Miyachi and Weiler discloses all of the above limitations, claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 are rejected.

8. Claims 5, 6, 9, 14, 15, 18, 23, 24, 27, 32, 33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyachi in view of Weiler, as applied above, further in view of Aikens et al. (U.S. Patent Number 5,414,494), hereinafter referred to as Aikens.

9. The combination of Miyachi and Weiler disclosed a multifunction peripheral that monitors and stores its status information and reports it to a host computer, including sequence, timing, or frequency information of user input. In an analogous art, Aikens disclosed a method for automatically notifying a remote device in response to certain machine conditions of a peripheral.

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10. Concerning claims 5, 6, and like claims, the combination of Miyachi and Weiler did not explicitly state such status conditions as a user exiting operation or a number of sessions to be executed. Miyachi sets forth a multitude of status conditions that are monitored by his multifunction peripheral but the majority of them are directed to mechanical properties of the apparatus. However, Aikens does explicitly disclose the certain status conditions as claimed as his system is more focused on setting status conditions directly related to the user's session with the machine. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Miyachi and Weiler by adding the ability to utilize such status conditions as a user exiting operation or a number of sessions to be executed as provided by Aikens. Here the combination satisfies the need for the ability to quickly alert a technician at a remote location of a certain status of a peripheral. See Miyachi, column 3, lines 35-42.

11. Concerning claims 9 and like claims, the combination of Miyachi and Weiler did not explicitly state communicating the log of the monitored data by Internet mail. However, Aikens does explicitly disclose this feature as his system provides for the use of email between the peripheral and the remote location. Furthermore, it is noted that although Aikens does not explicitly state use of the Internet, the ability to transfer email over the Internet was well known at the time of the applicant's invention and it would have been a clear extension to the system of Aikens to simply send his email using the Internet. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Miyachi and Weiler by adding the ability to

communicate the log of the monitored data by Internet mail as provided by Aikens. Again the combination satisfies the need for the ability to quickly alert a technician at a remote location of a certain status of a peripheral. See Miyachi, column 3, lines 35-42.

12. Thereby, the combination of Miyachi, Weiler, and Aikens discloses:

- <Claims 5, 14, 23, and 32>

A system according to Claim 1, wherein the communicating unit sends the log of the monitored data when the user exits operating the image forming device (Aikens, column 8, lines 24-31).

- <Claims 6, 15, 24, and 33>

A system according to Claim 1, further comprising a setting unit configured to set a number of sessions of the image forming device to be executed by the user prior to the communicating unit communicating the log of the monitored data (Aikens, column 8, lines 24-31).

- <Claims 9, 18, 27, and 36>

A system according to any one of Claims 5-8, wherein the communicating unit communicates the log of the monitored data by Internet mail (Aikens, column 6, lines 33-41 and figure 5, items 11 and "Mail").

Since the combination of Miyachi, Weiler, and Aikens discloses all of the above limitations, claims 5, 6, 9, 14, 15, 18, 23, 24, 27, 32, 33, and 36 are rejected.

(10) Response to Argument

I. The claim rejections under §103(a) as being unpatentable over Miyachi in view of Weiler should be affirmed.

There must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness. KSR Int'l v. Teleflex, Inc., 127 S. Ct. 1727, 1741 (2007). Such reasoning can be based on interrelated teachings of multiple patents and the background knowledge possessed by a person having ordinary skill in the art. KSR, 127 S. Ct. at 1740-41.

The motivation to combine references under §103 must come from a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the art, to look to particular sources, select particular elements, and to combine them as combined by the inventor. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000). An implicit motivation to combine exists when the combination of references results in a product or process that is more desirable. DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006).

A. Intended use language in claims 1 and 28

As a preliminary matter, the interpretation of claims 1 and 28 should take into account that the claims contain intended use language. Statements reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art.

Here, claims 1 and 28 recite a system and product respectively that contain different components that are “configured to” perform certain operations. The use of such “configured to” language should be interpreted merely as setting forth the intended use of the various

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components. For example, claim 1 recites a system with a monitoring unit configured to monitor data and generate a log and a communicating unit configured to receive a command and to send information through a network. Therefore, as long as the prior art system teaches a system with a monitoring unit that monitors and generates data and a unit that receives and sends commands over a network, then the prior art system meets the claim.

Similar remarks apply to claim 28.

B. Claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, and 35 rejected under 35 U.S.C §103(a)

Appellant argues that the combination of Miyachi and Weiler fail to disclose: (1) monitoring at least one of sequence, timing or frequency of selecting of the plurality of operations on an operation panel (Appellant's brief 10); (2) the monitoring unit and communicating unit being self contained in the image forming device (Br. 14); and (3) the image forming device having direct network access (Br. 16). Appellant's arguments should not be found persuasive for the following reasons.

1. The combination of Miyachi and Weiler disclose the limitations as claimed.

Miyachi and Weiler disclose the monitoring data of selecting of a plurality of operations and generating a log of the monitored data as claimed. Miyachi discloses an image forming device having a user interface that responds to user inputs. (Col. 5, ll. 27-29). Miyachi discloses monitoring the user input and upon "predefined entry in the user input device" certain information is displayed. (Col. 5, l. 66 to Col. 6). Thus, Miyachi does disclose monitoring the operation panel to insure that the predefined entry of user input is properly carried out.

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Weiler supplements Miyachi's teaching by producing a more desirable combination.

Weiler expressly disclose monitoring the sequence of the plurality of operations. The previous line citation to Weiler, column 4, lines 48-63, shows that usage information for the device is recorded by recording events based on user selection on the device. The device uses input prompts responsive to the sequence of keys pressed such as the operation of the "copies" button followed by the operation of the "finished" button. Weiler calls the inputs a "copy sequence." Additionally, Weiler discloses other operations such as "bind", "oversize", and "tabs." (Fig. 8). The combination of Miyachi and Weiler thus disclose monitoring the selection of a plurality of operations including monitoring at least one of a sequence of selecting of the plurality of operations.

Appellant specifically argues that Miyachi fails to disclose "monitoring of operations on an operation panel of an image forming device that a user selects." (Br. 11). Appellant further assert that the combination of Miyachi and Weiler fail to disclose logging the user's input of at least a sequence, timing, or frequency of selecting operations on an operation panel. (Br. 12-13).

Appellant admits that a device "must recognize which operations on an operation panel a user selects so that proper copying, scanning" operations are executed. (Br. 11). Appellant argues however that this feature is not the same as the claimed monitoring and logging operations because recognizing what selections an operate makes does not indicate that the operations are monitored and logged. (Br. 11). However, recognizing the operations input into the operation panel reads on monitoring the operations input into the operation panel.

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Appellant gives the example that Miyachi does not involve tracking the operations involved in changing an original document size of 11 x 17 to letter size or a paper size enlargement. (Br. 12-13). However, it is clear from Appellant's own example that the operations involved in the paper size enlargement must be monitored in order to properly effectuate the command sequence.

As to the logging function, the combination of Miyachi and Weiler also disclose generating a log of the monitored data. The previous line citation to Miyachi, column 5, lines 57-65, shows that the MFP's processor is responsible for monitoring conditions and updating the table. Updating the table with the status information that corresponds to the monitored input operations reads on Appellant's claimed generating of a log of the monitored data. Miyachi discloses that the predefined entry of user inputs corresponds to different operations as seen in Table 1. This functionality reads on Appellant's claimed log in the form of a mapping of key data (predefined entry of user input) to a value data (status operations in Table 1).

Additionally, Weiler supplements Miyachi's teaching by producing a more desirable combination. Weiler discloses recording operations within an event log table upon monitoring the sequence of selecting the plurality of operations. (Fig. 8, item 915 and col. 4, ll. 48-65). The ability to monitor and generate logs directed to the monitored data allows for accounting and billing. (Col. 1, ll. 31-34).

Appellant argues that Weiler's teaching is different from the claimed invention. Appellant gives another example whereby the claimed invention would operate differently from the Weiler. (Br. 14). According to Appellant, this difference is exemplified by a

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situation where a user makes a copy of one paper ten times by pressing the copy button ten times would be logged differently than if the user set the number of copies to ten and then pressed the copy button once. Appellant asserts that the claimed invention would record these two situations differently where Weiler would record them the same way.

The differences between the claimed invention and Weiler are not found in Appellant's claim language. The claims merely require generating a log of the monitored data containing a mapping of key data to a respective value data. Weiler's table records the copy event when certain operation sequences are input by the user. Thus, Weiler implicitly teaches that the recorded events are mapped to the user inputs.

2. Miyachi's monitoring unit and communication unit are self-contained in a single unit.

Appellant argues that since Miyachi does not disclose the same type of monitoring unit and communicating unit as claimed, Miyachi does not disclose the "same type of monitoring unit and communicating unit being self-contained in the device. (Br. 15). However, as discussed above, Miyachi does disclose the monitoring and communicating unit as claimed. Miyachi disclosed a monitoring unit and communicating unit being contained within an image forming device. (Fg. 2, item 110a and column 5, lines 57-65). Since Miyachi discloses the features as claimed, Appellant's discussion of Weiler is irrelevant.

3. Miyachi discloses an image forming device having direct network access.

Miyachi does teach that his multifunction peripheral (MFP) has network access via a host. Miyachi discloses that a host is considered to be a computer or "a group of network nodes on a given local area network." (Col. 2, ll. 28-30). Thus, if Miyachi's host were

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contemplated as a group of nodes on a local area network, one of ordinary skill in the art could have reasonably inferred that the MFP would have direct access to the local area network to communicate with the nodes.

In addition to this express teaching, providing an MFP or any network device with direct network access would have been obvious to one of ordinary skill in the art. Miyachi discloses several other related devices having direct network access (Fg. 1, items 180). Although these devices are different from Miyachi's multifunction peripheral with a monitoring unit and a communicating unit, they show that the ability to provide an image forming device with direct network access was already well known in the art.

Appellant specifically argues that Miyachi requires the MFP to communicate directly with the host and not through a network. (Br. 16). However, as discussed above, Miyachi discloses that the MFP can be connected to a group of hosts through a local area network.

(ii) Related Proceeding(s) Appendix

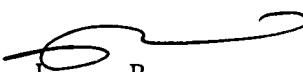
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

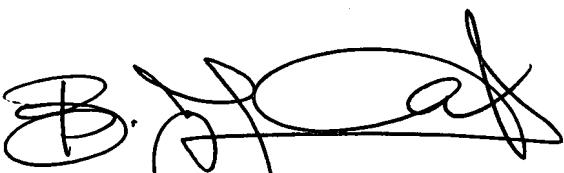
Respectfully submitted,

DC
November 16, 2007

Conferees:



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